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In re Application of : DECISION ON
Stuart A. KAUFFMAN et al :
Application No.: 09/868,981 : REQUEST UNDER
PCT No.: PCT/US99/30640 :
Int. Filing Date: 22 December 1999 : 37 CFR 1.497(d)
Priority Date: 22 December 1998 :
Attorney Docket No.: 9392-016-999 :
For: A SYSTEM AND METHOD FOR THE :
ANALYSIS AND PREDICTION OF :
ECONOMIC MARKETS :
:

This is a decision on applicant's "RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE" filed in the Patent and Trademark Office (PTO) on 22 January 2002, forwarding an executed declaration which adds inventor Vince M. Darley. The communication has been treated as a request under 37 CFR 1.497(d). Pursuant to authorization therein, the required petition fee of \$130.00 (37 CFR 1.17(I)) has been charged to counsel's Deposit Account No. 16-1150.

BACKGROUND

On 22 December 1999, applicants filed international application No. PCT/US99/30640, which designated the United States. A Demand electing, *inter alia*, the United States, was filed on 12 July 2000 prior to the expiration of 19 months from the priority date. Consequently, the deadline for entry into the national stage by paying the basic national fee in the U.S. expires as of midnight of 22 June 2001.

On 22 June 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, payment of the full U.S. basic national fee and an executed declaration was filed.

On 22 January 2002, the PTO mailed a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905) requiring a declaration in compliance with 37 CFR 1.497(a)-(b) and a surcharge for providing the oath and declaration later than the appropriate 20 or 30 months from the priority date.

On 22 January 2002 applicants' counsel filed a "RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE", which included a Declaration of the inventors. In this case, inventor VINCE M. DARLEY who is on the Declaration was not in the published international application.

DISCUSSION

A request under 37 CFR 1.497(d) states that "(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) ... the oath or declaration must be accompanied by:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter)."

A review of the application file reveals that applicants have satisfied items (1)- (3) but the not the introductory paragraph of 37 CFR 1.497(d).

With regard to item (1), the remarks submitted on 22 January 2002 are sufficient. VINCE M. Darley states that he was mistakenly not included as a named inventor of international application US99/30640 and that this error in inventorship in this international application occurred without any deceptive intention on his part.

With regard to item (2) it is satisfied because the processing fee of \$130.00 has been charged to Deposit Account 16-1150.

With regard to item (3), Bios Group Inc., the assignee, consents to the addition of inventorship of Vince M. Darley as an inventor of above application and has filed in the present request papers establishing their right to take action under 37 CFR §3.73(b).

With regard to the introductory paragraph of 35 USC 1.497(d), the declarations filed pursuant 35 U.S.C. 371(c)(4) are defective because they do not comply with 37 CFR 1.63. The Declarations do not appear to be complete; that is, a declaration with three sheets with all the signatures of the inventors. In this case, there are many more pages of sheets 2-3 (with the signature of the inventors) of the declaration than sheet 1, which there are only two. Therefore, some of submitted the declarations are incomplete.

Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office..



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